

REMARKS/ARGUMENTS

1.) Errors in Office Action

The present Office Action is denominated as "non-final," while the last Office Action, dated July 10, 2008, was denominated as "final." The present Office Action also states that "[t]his office action has been changed in response to the arguments filed on 9/9/2008," and that "Applicant's arguments with respect to claims 5, 8, 19-21, 24 and 25 have been considered but are moot in view of the new ground(s) of rejection." The Applicants have thoroughly reviewed the present office action and the prior office action, however, and can find no changes or new grounds of rejection; except for the Examiner's "Response to Arguments" section, it appears that the office actions are essentially identical. In view of the lengthy prosecution of this case, including an appeal to the Board of Patent Appeals and Interferences (BPAI), which reversed the Examiner's prior rejections of the claims, the Applicants respectfully request that the Examiner consult with their Supervisory Patent Examiner prior to issuing any further actions on the merits.

2.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 1, 3, 7, 10, 11, 13-16, 18 and 23 as being unpatentable over Beach in view of Larsson and Stewart; claims 5, 8, 19-21, 24 and 25 as being unpatentable over Beach in view of Larsson and Chen; claim 12 as being unpatentable over Beach in view of Larsson and Chen and further in view of van Bokhorst; claim 22 as being unpatentable over Beach in view of Larsson and Stewart and further in view of van Bokhorst. The Applicant, again, traverses the rejections.

Claims 1, 3, 7, 10, 11, 13-16, 18 and 23

In the present Office Action, the Examiner has maintained the previously-stated bases of rejection of all claims, and merely responded to Applicants' arguments traversing those rejections in a response filed on September 9, 2008. The Applicants reiterate those arguments and offer the following in rebuttal to the Examiner's response thereto.

The Examiner's response to Applicants' prior arguments consists solely of the statements that:

"The BPAI found 'no disclosure of any kind of interaction with a wireless network card'. Therefore, the teaching of Stewart which say [*sic*] that a 'wireless Ethernet card' (*i.e.* NIC) is required for a 'portable computing device' to be able to communicate with a 'wireless access point' is analogous art. In other words, all communications from a mobile terminal must be communicated through the NIC to make it to the access point. [] in order for Larsson's mobile terminal to request the access point to enter or exit power savings modes [], the request must be communicated through the wireless network card in order to reach the access point, as taught by Stewart."

The Examiner is correct that the BPAI found "no disclosure of any kind of interaction with a wireless network card [in the teachings of Larsson]." The Examiner's reliance on the teaching in Stewart of a wireless network card for a mobile terminal to communicate with an access point, however, is insufficient to overcome the BPAI's reversal of the Examiner's prior basis of rejection because the Examiner's argument completely disregards the other findings of the BPAI in reversing the Examiner's claim rejections in view of Beach and Larsson. In particular, as explained in the following, the Examiner has not rebutted Applicants' arguments that, although **Stewart does teach a NIC, it does not overcome the failure of Beach and Larsson to teach the "claimed interactions" recited in claim 1, to wit:**

- 1.) the mobile terminal requesting a transition from an active state to a less active state;**
- 2.) upon which request, the NIC sends a request to the AP that the mobile terminal be allowed to be entered into WLAN sleep state; and,**
- 3.) on receiving an acknowledgement from the AP, the mobile terminal enters WLAN sleep state.**

As noted by the Board of Patent Appeals and Interferences (BPAI), in overturning the Examiner's prior rejections based on the teachings of Beach and Larsson:

After reviewing the disclosures of Beach and Larsson in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief. With respect to Beach, to whatever extent

the Examiner may be correct in the finding that Beach discloses a mobile terminal, a wireless network card, and an access point, the Examiner has correctly recognized that Beach has no disclosure of any requests by the mobile terminal for a change in power state (appealed claim 1), nor any interaction of the mobile terminal with a network interface card to force a less active power state due to inactivity (appealed claim 13).

We also find no disclosure in Larsson that would overcome the deficiencies of Beach in disclosing the specific claimed interaction among the mobile terminal, the wireless network card, and the access point. While Larsson arguably provides a teaching of a mobile terminal communicating with a base station, *i.e.*, an access point, to request a transition to a less active power state, there is no disclosure of any kind of interaction with a wireless network interface card. Given this deficiency in the disclosure of Larsson, we fail to see how and in what manner Larsson might be combined with Beach to arrive at Appellants' invention as claimed. In view of the above discussion, we are of the opinion that, since the Larsson reference does not overcome the deficiencies of Beach discussed above, the references, even if combined, do not support the obviousness rejection. We, therefore, do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1 and 13, nor of claims 7, 11, and 14-16 dependent thereon. (emphasis added)

Despite the BPAI's reversal of the Examiner's prior reasons for claim rejections in view of Beach and Larsson, the Examiner has continued to use the same exact arguments, with the mere addition of Stewart for the teaching of a network interface card (NIC). The Examiner does recognize that Beach in view of Larsson "fails to explicitly recite the mobile terminal requests a NIC to communicate with the access point." To overcome this deficiency of Beach and Larsson, the Examiner looks to the teachings of Stewart, stating that Stewart "teaches a communication network . . . that includes portable computing devices . . . comprising a NIC . . . that is used for communicating with an access point." The Examiner, however, has not pointed to any disclosure in Stewart that, in combination with the disclosures of Beach and Larsson, would teach the "specific claimed interaction among the mobile terminal, the wireless network card, and the access point" (emphasis added) as noted by the BPAI with respect to the deficiencies in the teachings of Beach and Larsson. In other words, although Stewart

does teach a NIC, it does not overcome the failure of Beach and Larsson to teach the “claimed interactions” recited in claim 1, to wit:

- 1.) the mobile terminal requesting a transition from an active state to a less active state;
- 2.) upon which request, the NIC sends a request to the AP that the mobile terminal be allowed to be entered into WLAN sleep state; and,
- 3.) on receiving an acknowledgement from the AP, the mobile terminal enters WLAN sleep state.

The Applicants have again reviewed the teachings of Stewart, and note that its teachings do not relate to methods for power savings in a mobile terminal, much less to a method that involves the interactions between a mobile terminal, a wireless network card and an access point as recited in claim 1. Therefore, just as the BPAI noted with respect to the deficiencies in the teachings of Beach and Larsson, the teachings of Beach, Larsson and Stewart, “even if combined, do not support the obviousness rejection.

For similar reasons, the Examiner has failed to establish a *prima facie* case of obviousness of independent claims 3, 13 and 18 over Beach in view of Larsson and Stewart. Furthermore, whereas claims 7, 11 and 16 are dependent from claim 1, claims 10, 12 and 23 are dependent from claim 3, and claims 14 and 15 are dependent from claim 13, and include the limitations of their respective base claims, those claims are also not obvious over Beach in view of Larsson and Stewart.

Claims 5, 8, 19-21, 24 and 25

The Examiner rejected claims 5, 8, 19-21, 24 and 25 as being unpatentable over Beach in view of Larsson and Chen. As noted by the BPAI, in overturning the Examiner’s prior rejections based on the teachings of Beach and van Bokhorst in further view of Chen:

Lastly, we also do not sustain the Examiner’s obviousness rejection of claims 5, 8, 19-22, 24, and 25 in which the Chen reference is added to the combination of Beach and van Bokhorst to address the claimed feature of

a mobile terminal requesting to be disassociated or de-authenticated from an access point (independent claim 5) or from another mobile terminal (independent claim 8). While we agree with the Examiner (Answer 8-9) that Chen provides a disclosure of a mobile terminal requesting that it be disconnected from another mobile terminal, such a teaching does not overcome the deficiencies of Beach and van Bokhorst. As discussed previously, there is no disclosure in Beach or van Bokhorst of a mobile terminal making a request for a transition from a active state to a less active state, a teaching which is also missing from Chen. (emphasis added)

Despite the BPAI's reversal of the Examiner's prior reasons for claim rejections in view of Beach, van Bokhorst and Chen, the Examiner has repeated essentially the same exact arguments in the present Office Action based on the teachings of Beach, Larsson and Chen; i.e., the Examiner has merely replaced the van Bokhorst reference with Larsson. In the present Office Action, the Examiner asserts that Chen "teaches a method for disconnection in a mobile terminal where the mobile terminal can request to be disconnected from another mobile terminal in an ad hoc network." As noted *supra*, however, the BPAI expressly ruled that "there is no disclosure in Beach or van Bokhorst of a mobile terminal making a request for a transition from a active state to a less active state, a teaching which is also missing from Chen." Furthermore, as noted *supra* with respect to the BPAI's statements regarding the teachings of Larsson, Larsson also fails to overcome the deficiencies of Beach. Therefore, the Examiner's new reasons for rejection of claim 5 not only contradict the ruling of the BPAI, but also fail to establish a prima facie case of obviousness. As supported by the ruling of the BPAI, claim 8 is also not obvious over Beach in view of Larsson and Chen. Furthermore, whereas claims 19, 21 and 24 are dependent from claim 5, and claims 20, 22 and 25 are dependent from claim 8, and include the limitations of their respective base claims, those claims are also not obvious over Beach in view of Larsson and Chen.

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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1, 3, 5, 7, 8, 10-16 and 18-25.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

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